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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,832	06/26/2003	Tokimori Tomita	122.1046CD2	4081
21171	7590	05/02/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ALVAREZ, RAQUEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/603,832

**Applicant(s)**

TOMITA ET AL.

**Examiner**

Raquel Alvarez

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to communication filed on 2/14/2006.

#### **Election/Restrictions**

2. Newly submitted claim 11 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: associating services offered with corresponding points and classifying the services offered based on types.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 11 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy (5,117,355 hereinafter McCarthy).

With respect to claims 1-2, McCarthy teaches a point management system employing a computer for managing points issued to each consumer who receives service according to the issued discounts (Abstract). Point issue means for issuing

Art Unit: 3622

points to the consumer according to transactions performed by the customer (col. 1 , lines 24-27) ; point accumulation means for calculating and accumulating the issued points of a current transaction and issued point of a previous transaction (col. 1, lines 35-38); point notification means for instantaneously notifying the consumer of cumulative point information comprising the issued points (col. 1, lines 38-43); customer identification means for identifying the customer according to customer identification information (col. 1, lines 53-57).

With respect to notifying the customer of the types of services that can be redeemed for the accumulated points. Official notice is taken that it is old and well known to let the customers know what products or services can be redeemed based on the points accumulated. For example, frequent miles program or the like notifies the customers of the total mileage accumulated and the travel destination that the points can be used for. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included notifying the customer of the types of services that can be redeemed for the accumulated points in order to motivate the customer to achieve their goal.

Claims 3-7, 10 further recites that the point accumulation means displays colored striped line thereof and reduces the length of the striped line according to the decrease in points. Official notice is taken that it is old and well known to use diagrams such as graphs or the like for representing variation of a variable in comparison with that of one or more variables in order to provide an image or visual representation of the variables. It would have been obvious to a person of ordinary skill in the art at the time of

Art Unit: 3622

Applicant's invention to have included a point accumulation means displays colored striped line thereof and reduces the length of the striped line according to the decrease in points in order to achieve the above mentioned advantage.

Claim 8 further recites changing the point calculation art random within a predetermined range. Official notice is taken that it is old and well known to make changes to certain calculation at random so that the calculation will not predictable. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included changing the point calculation art random within a predetermined range in order to surprise the customer by making the calculation of the points unpredictable.

Claim 9 further recites reducing the points in proportion to when the consumer is being notified of the types of services corresponding to the points. Official notice is taken that it is old and well known to reduce the amount of the discount if is not redeemed in a timely manner in order to motivate the customer to make purchases. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included reducing the points in proportion to when the consumer is being notified of the types of services corresponding to the points in order to achieve the above mentioned advantage.

**Response to Arguments**

5. With respect to the official notice taken by the Examiner that notifying the customer of the types of services that can be redeemed for the accumulated purchases using diagrams for representing the variables and reducing the amount of the discount if redeemable. Applicant asserts that McCarthy does not teach, suggest, illustrate or enable such functions and that is not valid reasoning, but this is not relevant to the use of Official Notice. While applicant may challenge the examiner's use of Official Notice, applicant needs to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of. See MPEP 2144.03 where In re Boon is mentioned.

**Conclusion**

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

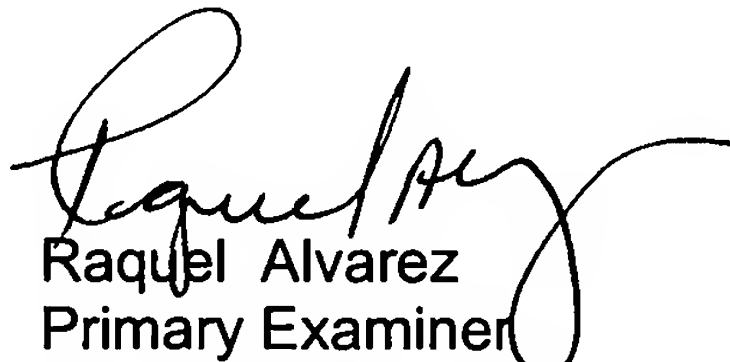
**Point of contact**

Art Unit: 3622

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
4/26/2006